

REMARKS

In the Office Action, the Examiner rejected claims 1-45. The Applicants respectfully traverse all of the Examiner's rejections and stress that the presently pending claims are patentable over the cited references. In view of the following remarks, Applicants request reconsideration and allowance of all pending claims.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-45 under 35 U.S.C. § 103(a) as unpatentable over Dunworth et al. (U.S. Patent No. 5,930,474) in view of Killcommons et al. (U.S. Patent No. 6,424,996). Claims 1, 16, 29, and 38 are independent. Applicants respectfully traverse this rejection.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the

ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Features of the Independent Claims Omitted from the Cited Combination

Independent claim 1 recites “the *medical locator system* is configured for *multiple modalities*.” The Examiner admitted correctly that the Dunworth et al. reference does not teach these recited features but asserted incorrectly that the Killcommons et al. reference does teach such features. See Paper 4, page 3. However, the Killcommons et

al. reference does *not* teach a medical *locator* system configured for multiple modalities, but instead discloses a technique for the electronic transfer of medical information *derived* from different medical modalities. Killcommons, col. 1, lines 16-19 and 49-51. In other words, the Killcommons et al. system is directed to the communication of patient medical information, such as clinical data and parameter data, to a remote place. However, Killcommons et al. do not even mention or suggest a locator system or information relating to the location of a given modality. Col. 1, lines 22-30; col. 6, lines 44-58. Accordingly, claim 1 and its dependent claims 2-15 are believed allowable over the cited combination.

Independent claims 16 and 29 each recite “a *resource locator system* configured for *locating a desired medical resource*.” The Examiner acknowledges correctly that Dunworth et al. does not teach these recited features. Paper 4, page 10. Applicants strongly emphasize that the secondary reference, Killcommons et al., also does not disclose these features. Instead, Kilcommons et al. is directed to satisfying the “need for medical transfer systems that allow for transfer of complex data from a variety of modalities over email and web browser systems.” Killcommons et al., col. 3, lines 52-55. The Examiner must not attribute teachings to the Killcommons et al. reference that are not disclosed therein. It is clear that the type of data disclosed in both references does not include location or other descriptive information that may be useful in locating a desired medical resource. Further, neither reference teaches a locator system configured to utilize such location or descriptive data. Indeed, the Examiner must not confuse the patient modality data of Killcommons et al. or the listing of hospitals (having only generic type information found in a phone book) disclosed in Dunworth et al. with a locator system and data directed to locating medical resources disposed in a given facility. *See, e.g.,* Dunworth, Figures 10 and 18. The two references, either alone or in combination, do not teach a resource locator system for locating medical resources. Accordingly, claims 16 and 29, and their respective dependent claims 17-28 and 30-37 are believed allowable over the cited combination.

Independent claim 38 recites “*client data* comprising a desired geographic region for *locating* at least one *medical resource* from a plurality of medical resources.” The Examiner admitted correctly that the Dunworth et al. reference does not teach a method for locating at least one medical resource from a plurality of medical resources. Paper 4, page 10. Further, the Killcommons et al. reference fails to obviate this deficiency of Dunworth et al. The secondary reference mentions medical modalities but does not teach locating a medical resource associated with a modality, much less *locating a medical resource* in general. To the contrary, the Killcommons et al. reference teaches the electronic transfer of *patient data*, without any regard to locating medical resources, as recited in the instant claims. *See, e.g.*, Killcommons et al., col. 1, lines 22-30; col. 6, lines 44-58.

Indeed, the failure of both references to disclosing the capability to locate, geographically or otherwise, a medical resource is highlighted by each reference’s complete lack of disclosure relating to *client data*. In some embodiments, such client data may include, for example, the needs of the patient, needs of the service provider, desired location or geographic region, experience of doctors and equipment operators, cost of procedure, wait time, etc. The cited combination simply fails to teach client data or locating a medical resource based on such data. *See, e.g.*, Killcommons et al., col. 1, lines 22-30; col. 6, lines 44-58 (teaching the electronic transfer of parameter and clinical data, with no mention of *data comprising a desired geographic region* or *client data*). The references, either alone or in combination, plainly do not teach “*client data* comprising a desired geographic region for *locating* at least one *medical resource*,” as recited by claim 38. Accordingly, claim 38 and its dependent claims 39-45 are believed allowable over the cited combination.

In sum, the Dunworth et al. and Killcommons et al. references fail to teach, suggest, or disclose each element of independent claims 1, 16, 29, and 38. Accordingly, Applicants strongly assert that the Examiner's rejection of the claims 1-45 cannot stand. Applicants respectfully request the withdrawal of the Examiner's rejection and allowance of claims 1, 16, 29, and 38, and the claims that depend therefrom. Furthermore, Applicants emphasize that the dependent claims are also allowable for other reasons by virtue of the subject matter recited in each dependent claim.

No Reason to Combine References – Lack of Objective Evidence

Even assuming, *arguendo*, that the cited combination teaches all of the features recited in the independent claims, the Examiner did not provide objective evidence of the requisite motivation or suggestion to combine or modify the Dunworth et al. and Killcommons et al. references. Instead, the Examiner combined the references based on the *conclusive and subjective* statement that "because wherein the medical locator system is configured for multiple modalities would allow for transfer of complex data from a variety of modalities over e-mail and web browser systems." See Paper 4, page 3. The Examiner, in modifying the on-line yellow pages of Dunworth et al. with the Killcommons et al. technique of transferring patient data (derived from a modality), employed impermissible hindsight reconstruction attempting to reach the present technique of locating medical resources. There is no reason to incorporate patient information, such as test results or an x-ray image, into the Dunworth et al. electronic yellow pages. Applicants respectfully stress that the Examiner has not met the evidentiary requirements, i.e., objective evidence, for the requisite motivation or suggestion to combine the cited references in the manner asserted by the Examiner or in the manner recited by the claims. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or in the alternative, the Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) and allow the claims.

The References Teach Away


Finally, Applicants stress that the Dunworth et al. and Killcommons et al. references teach away from one another. In fact, it is clear that it is not desirable, nor does it make sense, to incorporate the Killcommons et al. modality data, such as a patient's radiology image or sound recording, into the geographical search system for the consumer taught by Dunworth et al. *See, e.g.*, Dunworth, col. 7, lines 11-16 (explaining that a user can find an "out-of-print book" or a "good price on his favorite bottle of wine"); col. 9, lines 61-63 (noting that particular stores such as "Bill's Hardware" and "ACE Hardware" may be accessible under the topic "hardware stores."); col. 25, lines 25-27 (referring to a yellow pages database); and Killcommons et al., col. 1, lines 22-30; col. 6, lines 44-58 (teaching the electronic transfer of patient data). Indeed, incorporation of a patient's medical information into the Dunworth et al. system and search results would render the Dunworth et al. system inoperable for its intended purpose. The on-line yellow page system of Dunworth et al. is neither intended nor reasonably capable of processing the type/format of complex medical data taught in Killcommons et al. Indeed, inclusion of the Killcommons et al. patient data into the on-line consumer-information search system of Dunworth et al. would *change the principal of operation* of the Dunworth et al. system. After all, the ultimate output of the Dunworth et al. system is *either* further menu selections or web destinations that satisfy the consumer's search criteria. Dunworth et al. has no configuration, as in Killcommons et al., for receiving or outputting patient data. *See* Dunworth, col. 2, lines 56-58. There is simply no reason to believe that the Dunworth et al. system can accommodate the transfer of large medical files of varying formats, for example. As stated in the foregoing legal precedent, it is improper to combine references where the references teach away from their combination. Accordingly, Applicants respectfully assert that the instant pending claims 1-45 are patentable for this reason as well.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 6, 2004

A handwritten signature in black ink, appearing to read 'Taj R. Swanson', written over a horizontal line.

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